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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/726,024	10/04/1996	DANIEL A. HENDERSON	317MH-23513	8599

7590 12/16/2002

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EXAMINER

WEAVER, SCOTT LOUIS

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/726,024

Applicant(s)

HENDERSON, DANIEL A.

Examiner

Scott L. Weaver

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 54-188 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 54-188 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **Part III RESTRICTION REQUIREMENT**

#### ***Response to Amendment***

1. Applicant's arguments filed 9/30/02 with respect to claims 54-188 have been considered but are moot.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 54-56 and 86-122 drawn to a method which receives caller identification data from a telephone network at a telephone answering device (TAD) and the TAD converts the data to a voice signal for transmission to end user device, classified in Class 379, subclasses 142.01, Telephonic Communications, Reception of Calling Information at Substation in Wireline communication system.

Claims 54-56 and 86-122 present an inventive feature distinct to the respective inventive features of the subsequent claim groupings, the features of the TAD performing conversion provides a distinct invention which does not require each of the features of the subsequently presented subject matter and could be manufactured, sold and used in a product separate from and thus distinct of the remaining groups of inventions requiring particularly different inventive features.

Each of the remaining groups of claims do not require the TAD to Convert the caller ID data to voice signals.

Likewise, the immediate group I claims do not require receiving voice signal Caller Identification Data from a telephone network at a TAD (group II), the paging network receiving the caller identification data and the paging network using a voice synthesizer to convert the data to voice signals (group III), nor the portable device receiving the caller identification data and the user portable device using a voice synthesizer to convert the caller identification data to voice signals as in (group IV).

As such, the group I invention could be made, used, and sold as a product separate from and distinct from the inventions of the remaining group II-IV claims.

Group II Claims 57-85, drawn to a method of receiving voice signal Caller Identification Data from a telephone network at a TAD classified in Class 379, subclass 67.1 Telephonic Communications With Audio Message Storage or Retrieval.

Claims 57-85 present a distinct invention which does not require the particular inventive features of the subsequent limitations or the previous limitations presented in the subsequent claims and previous claims respectively, and could be manufactured, sold, and used as an invention distinct from the inventions presented in the non-related claim groupings.

Each of the remaining groups of claims do not require receiving voice signal Caller Identification Data from a telephone network at a TAD.

Likewise, the immediate group II claims do not require a TAD to Convert the caller ID data to voice signals as per (group I), a paging network receiving the caller identification data and the paging network using a voice synthesizer to convert the data to voice signals (group III), nor a portable device receiving the caller identification data and the portable device using a voice synthesizer to convert the caller identification data to voice signals as in (group IV).

As such, the group II invention could be made, used, and sold as a product separate from and distinct from the inventions of the remaining group I and III-V claims.

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Group III Claims 123-156 is drawn to a method of receiving caller identification data at a paging network and the paging network using a voice synthesizer to generate voice signals to transmit to a portable device, classified in Class 340 , subclass 7.62, Communications, Electrical, paging with audible alert.

Claims 123-156 of group III presents a distinct invention which does not require the particular inventive features of the subsequent limitations or the previous limitations presented in the subsequent claims and previous claims respectively, and could be manufactured, sold, and used as an invention distinct from the inventions presented in the non-related claim groupings.

Each of the remaining groups of claims do not require receiving caller identification data at a paging network and the paging network using a voice synthesizer to generate voice signals to transmit to a portable device as in the immediate group III claim.

Likewise, the immediate group III claim does not require a TAD to Convert the caller ID data to voice signals as per (group I), receiving voice signal Caller Identification Data from a telephone network at a TAD (group II), nor a portable device receiving the caller identification data and the user portable device using a voice synthesizer to convert the caller identification data to voice signals as in (group IV).

As such, the group III invention could be made, used, and sold as a product separate from and distinct from the inventions of the remaining group I-II and IV-V claims.

Group IV Claims 157-188, drawn to a method with a portable device receiving caller identification data from a paging network and using a voice synthesizer in the portable device to generate voice signals at the portable device, classified in Class 340 subclass 7.54, Communications, Electrical, paging message presentation via externally coupled device.

Claims 157-188 of group IV presents a distinct invention which does not require the particular inventive features of the subsequent limitations or the previous limitations presented in the subsequent claims and previous claims respectively, and could be manufactured, sold, and used as an invention distinct from the inventions presented in the non-related claim groupings.

Each of the remaining groups of claims do not require a portable device receiving caller identification data from a paging network and using a voice synthesizer in the portable device to generate voice signals as in the immediate group IV claims.

Likewise, the immediate group IV claims do not require a TAD to Convert the caller ID data to voice signals as per (group I), receiving voice signal Caller Identification Data from a telephone network at a TAD (group II), nor a paging network using a voice synthesizer to convert caller ID data to voice signals (group III).

As such, the group IV invention could be made, used, and sold as a product separate from and distinct from the inventions of the remaining group I-III and V claims.

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3. The inventions of each group are distinct, each from the other because the inventions of each group present distinct inventive features which are not required for the purpose of the distinct inventive features presented respectively in non-grouped claims as has been pointed out above, and as can be clearly realized by the reading of the claims as presented for examination.

Because these inventions are distinct for the reasons given above and the search required for the plural Groups indicated above is not required in each of the plural groups indicated, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, restriction for examination purposes as indicated is proper.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**


(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is (703) 308-6974. The examiner can normally be reached on Monday through Friday from 8:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4750 or to 2600 Customer Service at 703-306-0377.

  
SCOTT L. WEAVER  
PRIMARY EXAMINER  
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